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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1958

NO. 554

PREFORMED LINE PRODUCTS COMPANY

Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,

Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

PATRICK H. HUME,
HENRY L. BRINKS,
38 South Dearborn Street,
Chicago 3, Illinois.

C. WILLARD HAYES,
GEORGE M. SIRILLA,
American Security Building,
Washington 5, D.C.

Attorneys for Petitioner

TWENTIETH CENTURY PRESS, INC., CHICAGO 6

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Interference Termination

Respondent's statement (Res. Br. 5, 6) regarding termination of the interference between Peterson and Bodendieck points to major differences in viewpoint between respondent and petitioner respecting a critical area of this case.

The real issue before the Court involving the *inter partes* appeal to the Court of Customs and Patent Appeals (CCPA), during the pendency of which Bodendieck purged his patent of the interfering claims by statutory disclaimer, was, and is: What effect did this have on the pendency of the interference?

Petitioner contends that the contest ended December 7, 1950, when the disclaimer was made of record,* while respondent argues that the interference continued in good standing until the limit for perfecting the appeal expired two weeks later, on December 22, 1950.

The very concept that one party to an *inter partes* contest may abandon his claim and withdraw without vitiating the contest is repugnant to the elementary definition of an interference, which is that there must be rival claimants for the invention.**

What remained after the nonsuit effected by the disclaimer was a *de facto ex parte* action involving only the rights of petitioner's assignor, Peterson. The CCPA was without jurisdiction to entertain an appeal, the justiciable issues of which had been extinguished. The Commissioner, relying on CCPA Rule XXV, denied his original jurisdiction to take the necessary action to dissolve the contest as petitioner moved him to do. The trial court later ruled that the Commissioner had original jurisdiction (Conclusion of Law 15, Pet. App. A-13. Order denying defendant's motion to amend by striking this conclusion, Pet. App. A-4). There is thus posed an open conflict between CCPA Rule XXV and Patent Office Rules 262(a) and (d), and Rule 263.

Board of Appeals Denied Review

Respondent's argument *contra* (p. 6) notwithstanding, the Board of Appeals literally held that it was without jurisdiction to review a final rejection, *ex parte*, by the

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* Patent Office Rules 262(a) and (d); Rule 263, Petitioner's Appendix A-18, A-19. Statement of Questions presented to the Court of Appeals, Questions No. 1 and 2, Petitioner's Appendix A-20, A-21, referred to in the 7th Question Presented to this Court, Petition 3. *Lattig et al.* v. *Dean*, 25 App. D.C. 592; 1905 C. D. 698; *Moore et al.* v. *Bradley* v. *Doering, Jr.* 1912 C. D. 205, 180 O. G. 879; *McCoy* v. *Pfeiffer* (CCPA 1943), 133 F. (2d) 913.

** *Lattig et al.* v. *Dean, supra.*

primary examiner, when that rejection was based on, or embodied among its reasons, a decision of the Interference Board and/or of the Commissioner of Patents (Joint App. 341, 431). This would appear clearly to contravene the unequivocal language of the Statute 35 USC §7*, which states ". . . (the) Board of Appeals * * * *shall review* adverse decisions of examiners upon application for patents" (emphasis added) and to contravene Sec. 134 of Title 35* as to petitioner's right to such a review on the merits.

Petitioner is Entitled to a Decision Now

While admitting this petition is properly before the Court, respondent says (p. 9):

> ". . . the petitioner will in no way be prejudiced by applying for a new trial since that contention can be asserted again when the judgment of the District Court is again reviewed by the Court of Appeals. And, of course, after final judgment by the Court of Appeals, the petitioner will then again be able to apply to this Court for a writ of certiorari. . . . Consequently, review by this Court, at this time, is clearly unwarranted."

This reflects a casuistic attitude in total disregard of how petitioner's resources would thus be taxed and dissipated. The first of the applications for patent before the Court came into being in 1946; the second in 1948. For twelve years the issues have been maturing and multiplying. The cost in time, labor, and monetary expense has been great, involving two interferences from inception to judgment; an *inter partes* appeal to the CCPA; two *ex parte* appeals to the Board of Appeals in the Patent Office; innumerable petitions for reconsideration, and to the Commissioner of Patents; and, finally, the proceedings to the District Court

* Petitioner's App. A-14.

under 35 USC §145; an appeal to the Circuit Court of Appeals; a petition for rehearing, and this petition.

Respondent now suggests that petitioner should be sent back to start all over again in the district court, whereby all of its labor for more than four years last past in the federal courts shall be abandoned without a single determinative issue having been decided along the way.

This is repugnant to the ways of our American jurisprudence, and to the principle of expediting the trial of cases in relief of litigants. The Board of Appeals in the Patent Office refused its duty; the trial court went seemingly afield of its duty; the Court of Appeals, likewise, refused to decide any of the affirmative issues in the case; and now respondent would have this Court refuse this petitioner the Writ because it has the power, and because petitioner retains the right to go the circuit court round again if it has the resources to do so. It lies with this Court to afford petitioner relief from such negative thinking that prolongs litigation, frustrates justice, and sterilizes petitioner by legal attrition.

The Whole Case is Before the Court

Petitioner denies respondent's argument (p. 9) that only the jurisdictional issue is raised by its petition. The fifth and seventh questions presented (Pet. 3) clearly embrace those questions of *res judicata* that were before the Court of Appeals (Pet. App. A-20, A-21). Consequently, petitioner does here and now contest the District Court's holding that the Interference Board's decision stands *res judicata* against it, and invites this Court to review the matter under its Supervisory Authority.*

Butterworth v. *Hoe*, 112 U. S. 50, does not warrant re-

* Ridings v. Johnson, 128 U. S. 212, 218; Petition for Rehearing 6

spondent's disregard of the powers invested in the Commissioner of Patents by the Congress. This case, without more, justifies petitioner's sixth question presented to this Court. Nor does respondent take into account why this Court in *Hoover* v. *Coe;* 325 U. S. 79 (an *ex parte* case) reversed the Court of Appeals, which relied upon Hill v. Wooster, 132 U. S. 693, an *inter partes* action.*

The language of 35 USC §145 appears to leave no room for the *sua sponte* ruling of the trial court as to claims not first passed on by the Board of Appeals, which were approved for patent by the Commissioner. In the absence of an assignment of error, *Butterworth* v. *Hoe, supra,* leads to the irresistible conclusion that the Commissioner's judgment favorable to patentability is final, and no reviewable issue remains for referral to the Court under the Statute.

Conclusion

The Writ should issue to settle the jurisdictional question, and to review the several questions appearing in petitioner's Statement of Questions Presented, First to Seventh (Pet. 2, 3), including those before the Court of Appeals (Pet. App. A-20, A-21).

Respectfully submitted,

PATRICK H. HUME,
HENRY L. BRINKS,
38 South Dearborn Street,
Chicago 3, Illinois.

C. WILLARD HAYES,
GEORGE M. SIRILLA,
American Security Building,
Washington 5, D. C.
Attorneys for Petitioner

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* Petition for Rehearing 11.